

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

Filed by: Trial Section Merits Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

BRUCE K. WINKER

Junior Party,
(Patent No. 5,612,801)¹

v.

ADIEL ABILEAH, GANG XU,
and PATRICK F. BRINKLEY

Senior Party
(Application 08/881,667)²

Patent Interference No. 104,372

¹ Filed September 30, 1994. Accorded the benefit of application 08/223,251, filed April 4, 1994, now Patent No. 5,504,603, granted April 2, 1996. The real party in interest is Rockwell Science Center, LLC.

² Filed June 24, 1997. Accorded the benefit of application 08/595,068, filed February 1, 1996, application 08/451,962, filed May 26, 1995, now Patent No. 5,818,615, granted October 6, 1998, and application 08/160,731, filed December 2, 1993, now Patent No. 5,499,126, granted March 12, 1996. The real party in interest is OIS Optical Imaging Systems, Inc.

Interference No. 104,372
Winker v. Abileah

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

JUDGMENT UNDER 37 CFR § 1.662(b)

This interference was declared on September 15, 1999. At
the time of declaration, the count was as follows:

Count 1

[Abileah claim 96]

A compensator for a liquid crystal display
comprising:

(a) a first deposited thin-film compensator
layer having a first surface;

(b) a second thin-film compensator layer
deposited onto said first surface of said first
compensator layer, wherein each of said first and
said second deposited thin-film compensator layers
are selected from the group consisting of: (i) a
positively birefringent A-plate compensator layer,
and (ii) a negatively birefringent C-plate
compensator layer.

or

[Winker claim 1]

A monolithic compensator for a liquid crystal
display comprising:

(a) a first deposited thin-film compensator
layer having a first surface;

(b) a second thin-film compensator layer
deposited onto said first surface of said first
compensator layer, wherein each of said first and

Interference No. 104,372
Winker v. Abileah

said second deposited thin-film compensator layers are selected from the group consisting of: (i) a positively birefringent O-plate compensator layer, (ii) a positively birefringent A-plate compensator layer, (iii) a negatively birefringent A-plate compensator layer and (iv) a negatively birefringent C-plate compensator layer.

Interference No. 104,372
Winker v. Abileah

A. First conference call

A first telephone conference call was held on 3 November 1999, involving:

1. John J. Deinken, Esq., counsel for junior party Winker;
2. Joseph A. Rhoa, Esq., counsel for senior party Abileah; and
3. Jameson Lee, Administrative Patent Judge (APJ).

B. Discussion--first conference call

Winker informed the APJ that junior party Winker intends to file a reissue application which limits the first deposited thin-film compensator layer of all Winker claims corresponding to the count to a positively birefringent O-plate layer, to add the reissue application to this interference, to change the count to require a positively birefringent O-plate layer as the first deposited thin-film compensator layer, and to designate all of Abileah's claims corresponding to the present count as not corresponding to the proposed new count.

Abileah informed the APJ that if the count is changed as was proposed by Winker, Abileah cannot prevail on priority. The parties agreed that there would be no interference-in-fact

Interference No. 104,372
Winker v. Abileah

between Abileah's claims and all claims Winker proposed to include in Winker's reissue application, since all claims in the Winker reissue application will require a positively birefringent O-plate layer as the first deposited thin-film compensator layer. The APJ took the information under advisement

C. Second conference call

A second telephone conference call was held on 3 November 1999, involving:

1. John J. Deinken, Esq., counsel for junior party Winker;
2. Joseph A. Rhoa, Esq., counsel for senior party Abileah; and
3. Jameson Lee, Administrative Patent Judge (APJ).

D. Discussion--second conference call

The APJ proposed the following to the parties:

1. The APJ will sua sponte change the count to read the same as Abileah's application claim 96, which requires each of the first and second deposited thin-film compensator layer to be selected from the group consisting of (i) a positively

birefringent A-plate compensator layer, and (ii) a negatively birefringent C-plate compensator layer.

2. All claims which corresponded to the original count will be designated as corresponding to the proposed new count.

3. Winker will file its reissue application to limit each claim to a first deposited thin-film compensator layer which is made of a positively birefringent O-plate layer and include no claim which in Winker's opinion corresponds to the modified count.

4. Under 37 CFR § 1.662(b), Winker's filing of such a reissue application will operate as a request for entry of adverse judgment as to the subject matter of the modified count.

5. After filing of the reissue application, the Board will enter judgment in favor of Abileah, and Winker will be left to pursue its reissue application claims before an examiner, in ex parte prosecution, and Winker runs the risk of an examiner finding that the reissue application claims are not

Interference No. 104,372
Winker v. Abileah

patentably distinct from the subject matter of the lost count. The examiner may uncover references sufficient to render Winker's reissue application claims obvious in view of the subject matter of the lost count.

The APJ instructed the parties to consider the proposed course of action and to contact the APJ in a joint telephone conference call to inform him as to their decision.

E. Third conference call

A third telephone conference call was held 10 November 1999, at approximately 2:00 p.m. (1400 hours Eastern Time), involving:

Interference No. 104,372
Winker v. Abileah

1. John J. Deinken, Esq., counsel for junior party
Winker;
2. Joseph A. Rhoa, Esq., counsel for senior party
Abileah; and
- 3 Jameson Lee, Administrative Patent Judge (APJ).

F. Discussion--third conference call

The parties advised the APJ that the actions proposed by the APJ are agreeable to the parties. In particular, the parties represented that the filing by Winker of a reissue application all of which claims require the first deposited thin-film compensator layer to be a positively birefringent O-plate layer will operate as a request for entry of adverse judgment against Winker as to the subject matter of a modified count which requires each of the first and second deposited thin-film layer to be selected from the group consisting of (i) a positively birefringent A-plate compensator layer, and (ii) a negatively birefringent C-plate compensator layer.

G. On November 10, 1999, the APJ re-declared the interference (Paper No. 18) to change the count to the following:

A compensator for a liquid crystal display
comprising:

Interference No. 104,372
Winker v. Abileah

(a) a first deposited thin-film compensator layer having a first surface;

(b) a second thin-film compensator layer deposited onto said first surface of said first compensator layer, wherein each of said first and said second deposited thin-film compensator layers are selected from the group consisting of: (i) a positively birefringent A-plate compensator layer, and (ii) a negatively birefringent C-plate compensator layer.

All of the claims which corresponded to the original count were designated as corresponding to the modified count.

H. On November 15, 1999, Winker filed a reissue application to reissue its involved patent in this interference. The original independent claims were amended to require the first deposited thin-film layer to be a positively birefringent O-plate compensator layer.

I. Fourth conference call

A fourth telephone conference call was held 19 November 1999, at approximately 3:00 p.m. (1500 hours Eastern Time), involving:

1. John J. Deinken, Esq., counsel for junior party Winker;
2. Joseph A. Rhoa, Esq., counsel for senior party Abileah; and

Interference No. 104,372
Winker v. Abileah

3 Jameson Lee, Administrative Patent Judge (APJ).

J. Discussion--fourth conference call

The parties confirmed to the APJ that in their view Winker's reissue application does not contain any claim that corresponds to the modified count, and that judgment should issue in favor of Abileah as to the subject matter of the modified count.

K. The parties' joint position that all of Winker's reissue claims do not correspond to the modified count appears facially plausible on this record, in the absence of any evidence to which we have been directed. In this circumstance, entry of adverse judgment with respect to Winker's involved patent is authorized under 37 CFR § 1.662(b). We regard the filing of the Winker reissue application as constituting a request for entry of adverse judgment as to the subject matter of the modified count. The request is granted.

L Order

Upon consideration of the record, it is

ORDERED that junior party Winker is not entitled to its patent claims 1-7, which correspond to the count.

Interference No. 104,372
Winker v. Abileah

FURTHER ORDERED that senior party Abileah is entitled to its application claims 96-102 which correspond to the count.

FURTHER ORDERED that judgment is entered with prejudice as to Winker's involved patent claims 1-7, but that Winker is free to pursue, in ex parte, before a primary examiner claims now pending in its reissue application which limit the first deposited thin-film layer to a positively birefringent O-plate compensator layer, by arguing that such claims would not have been obvious over the lost count.

FURTHER ORDERED that nothing in this JUDGMENT UNDER 37 CFR § 1.662(b) should be construed as expressing an opinion on the patentable distinction or lack thereof between Winker's reissue application claims and the subject matter of the count. The examiner is free to make his or her own determination in that regard, and that Winker shall bring to the examiner's attention the substance of this particular paragraph.

FURTHER ORDERED that should further prosecution by Winker of its reissue application result in an appeal to the

Interference No. 104,372
Winker v. Abileah

board, Winker shall identify this interference as a related
case.

	<hr/>	FRED E. McKELVEY, Senior)	
		Administrative Patent Judge)	
)	
)	
	<hr/>)	
		RICHARD E. SCHAFER)	BOARD OF
PATENT)	
		Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	<hr/>)	
		JAMESON LEE)	
		Administrative Patent Judge)	

Interference No. 104,372
Winker v. Abileah

By Federal Express:

Attorney for senior party Abileah
(real party in interest
OIS Optical Imaging Systems, Inc.):

Joseph A. Rhoa
6550 Rock Spring Drive, Suite 240
Bethesda, Maryland 20817

Attorney for junior party Winkler
(real party in interest
Rockwell Science Center, LLC.):

John J. Deinken
P.O. Box 1085, MC A15
Thousand Oaks, California 91358-0085